

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Sylvie ROUX et al.)	Art Unit: 1632
)	
Patent No.: 7,923,216)	Examiner: CHEN, Shin Lin
)	
Issued: April 12, 2011)	Confirmation No.: 2497
)	
For: IN VIVO MODULATION OF)	
NEURONAL TRANSPORT)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPLICATION FOR PATENT TERM ADJUSTMENT-POST GRANT

In accordance with 37 C.F.R. § 1.705(b), Applicant hereby applies for patent term adjustment under 35 U.S.C. § 154(b) of a total of 1521 days. This application is being filed within two months of issuance of the above patent, as required by 37 C.F.R. § 1.705(d).

I. Statement of the Facts Involved

A. Correct Patent Term Adjustment

According to information printed on the face of the above-identified issued patent, this patent is entitled to 1401 days of patent term adjustment. Applicant has calculated a patent term adjustment of 1521 days based on the following facts:

The Office calculated A delay of 723 days, B delay of 1333 days, and overlap of 212 days for the instant patent according to PAIR. See the Patent Term Adjustment printout attached hereto as Exhibit A. These calculations are not contested in this paper.

The Office calculated Applicant delay of 443 days. *Id.* This includes 120 days of Applicant delay for what the Office designates a “Miscellaneous Incoming Letter” filed May 12, 2010, after the mailing of a Notice of Allowance and simultaneous with the payment of the Issue Fee. *Id.* at entry 115. Applicant respectfully submits that nothing filed on May 12, 2010, should have resulted in Applicant delay, for the reasons discussed below. Therefore, the Office’s calculation of total Applicant delay is incorrect. Removing this deduction of 120 days results in Applicant delay of 323 days. Therefore, the total amount of Patent Term Adjustment should be 1521 days, calculated as follows: $723 \text{ (A delay)} + 1333 \text{ (B delay)} - 212 \text{ (overlap)} - 323 \text{ (Applicant delay)} = 1521$.

Reductions to Patent Term Adjustment result from “failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application.” 37 C.F.R. § 1.704. While “[s]ubmission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed” can result in a reduction, § 1.704(c)(10), “[c]ertain papers filed after allowance are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application.” M.P.E.P. § 2732; *see also Clarification of 37 CFR 1.704(c)(10)*, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001). “The submission of the following papers after a ‘Notice of Allowance’ is **not** considered a failure to engage in reasonable efforts to conclude processing or examination of an application: (1) Fee(s) Transmittal (PTOL-

85B); . . . (4) Change of Address; . . . (6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the 'Notice of Allowance' or 'Notice of Allowability;'" M.P.E.P. § 2732 (emphasis in original).

The papers filed on May 12, 2010, do not constitute failure to engage in reasonable efforts to conclude processing or examination of an application because each of these papers is covered by an exception to § 1.704(c)(10). A complete copy of the set of papers filed on May 12, 2010, is attached as Exhibit B. The papers filed on May 12, 2010, consisted of the following:

- Issue Fee Transmittal
- Fee Address for Maintenance Fee Purposes
- Notice of Possible PTO Error in Determination of Patent Term Adjustment ("Candor Letter")

The Issue Fee Transmittal and the Fee Address for Maintenance Fee Purposes (i.e., Change of Address) are expressly excepted from the scope of § 1.704(c).

The Candor Letter is a request to correct an error or omission in the Notice of Allowance, which included a Determination of Patent Term Adjustment that appeared to be erroneous (although the Office did not respond to this request). Applicant respectfully points out that filing this paper cannot be construed as a failure by the Applicant to engage in reasonable efforts to conclude processing or prosecution because it was impossible to point out the possibility of an error in Patent Term Adjustment until the mailing of a Notice of Allowance, informing Applicant of the Office's PTA determination. This is different from papers, such as an Amendment or Drawings, that do trigger a reduction of PTA when filed after a Notice of Allowance, because it is possible to file papers, such as an Amendment or Drawings earlier.

Furthermore, for the Office to consider such an action to be a failure to engage in reasonable efforts is inconsistent with the Office having required practitioners to disclose possible errors and having suggested the use of letters to do so. See *Changes To Implement Patent Term Adjustment Under Twenty-Year Patent Term*, 65 Fed. Reg. 56366, 56387 (Sept. 18, 2000) ("if a registered practitioner . . . believes that the [patent term] adjustment should be [less than the amount determined by the Office], the practitioner does have a duty to disclose the error to the Office [A] letter could be filed with the issue fee payment, indicating that the term adjustment is thought to be longer than appropriate.")¹ It would be unreasonable for the Office to have required Applicant to file a notification when an error is believed to be present, and then to penalize the Applicant for providing that notification by reducing PTA.

For the above reasons, nothing in the filing of May 12, 2010, constituted a failure to engage in reasonable efforts to conclude processing and examination of the application. Therefore, Applicant respectfully requests that the Patent Term Adjustment be corrected by removing the 120 day deduction in connection with the filing of May 12, 2010, resulting in a Patent Term Adjustment of 1521 days.

B. Terminal Disclaimer

The above-identified patent is not subject to a Terminal Disclaimer.

¹ This guidance appears to have been superseded in a later Notice. See *Treatment of Letters Stating That the USPTO's Patent Term Adjustment Determination Is Greater Than What the Applicant or Patentee Believes Is Appropriate*, 75 Fed. Reg. 42079 (July 20, 2010). However, this July 20, 2010, Notice is of course irrelevant to the treatment of a filing that occurred previously, on May 12, 2010.

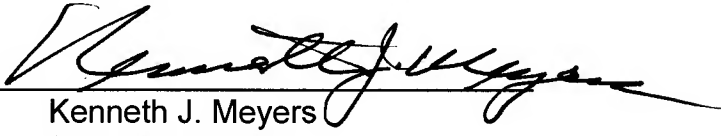
II. Fee

This application is accompanied by a payment of \$200.00 to cover the fee required by 37 C.F.R. § 1.705(b)(1). Please charge any deficiencies to Deposit Account 06-0916. If there are any other fees due in connection with the filing of this request, please charge them to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 13, 2011

By: 
Kenneth J. Meyers
Reg. No. 25,146
(202) 408-4033
Fax: (202) 408-4400
E-mail: Ken.Meyers@finnegan.com

Attachments: Exhibit A
Exhibit B

EXHIBIT A

10/662,808 IN VIVO MODULATION OF NEURONAL TRANSPORT**04-05-2011::19:47:39****Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 10/662,808

Filing or 371(c) Date:	09-16-2003	Overlapping Days Between {A and B} or {A and C}:	212
Issue Date of Patent:	-	Non-Overlapping USPTO Delays:	1844
A Delays:	723	PTO Manual Adjustments:	0
B Delays:	1333	Applicant Delays:	443
C Delays:	0	Total PTA Adjustments:	1401

Patent Term Adjustment History Explanation Of Calculations

Number	Date	Contents Description	PTO(Days)	APPL(Days)	Start
118.5	04-12-2011	PTA 36 Months	1333		0.5
118	04-12-2011	Patent Issue Date Used in PTA Calculation	212		110
117	03-14-2011	Export to Final Data Capture			0
116	03-11-2011	Dispatch to FDC			0
115	05-12-2010	Miscellaneous Incoming Letter		120	0
111	05-14-2010	Application Is Considered Ready for Issue			0
110	05-12-2010	Issue Fee Payment Verified			0
109	05-12-2010	Issue Fee Payment Received			0
108	05-04-2010	Finished Initial Data Capture			0
107	04-23-2010	Workflow - Query Request - Finish			0
106	04-13-2010	Printer Rush- No mailing			0
105	03-26-2010	Pubs Case Remand to TC			0
104	03-31-2010	Workflow - Query Request - Begin			0
103	03-11-2010	Receipt into Pubs			0
101	03-09-2010	Sequence Forwarded to Pubs on Tape			0
100	02-26-2010	Export to Initial Data Capture			0
99	02-24-2010	Mail Notice of Allowance			0
98	02-23-2010	Issue Revision Completed			0
97	02-23-2010	Document Verification			0
96	02-22-2010	Allowed Case Returned to the Examiner for Clerical Processing			0
94	02-22-2010	Notice of Allowance Data Verification Completed			0
93	02-22-2010	Case Docketed to Examiner in GAU			0
92	02-10-2010	Allowability Notice			0
91	11-16-2009	Information Disclosure Statement considered			0
89	11-16-2009	Reference capture on IDS			0
88	11-16-2009	Information Disclosure Statement (IDS) Filed		0	86
87	12-31-2009	Date Forwarded to Examiner			0
86	11-16-2009	Response after Non-Final Action			0
85	11-16-2009	Information Disclosure Statement (IDS) Filed			0
84	08-17-2009	Mail Non-Final Rejection			82
83	08-17-2009	Non-Final Rejection			0
82	07-28-2009	Notice of Appeal Filed			0

81	07-28-2009 Request for Extension of Time - Granted		0
79	06-18-2009 Amendment after Final Rejection	50	70
78	06-27-2009 Date Forwarded to Examiner		0
77	06-18-2009 Amendment after Final Rejection		0
76	06-18-2009 Request for Extension of Time - Granted		0
75	05-15-2009 Mail Advisory Action (PTOL - 303)		0
74	05-12-2009 Advisory Action (PTOL-303)		0
72	05-06-2009 Date Forwarded to Examiner		0
71	04-16-2009 Amendment after Final Rejection		0
70	01-29-2009 Mail Final Rejection (PTOL - 326)		0
69	01-27-2009 Final Rejection		0
68	10-28-2008 Information Disclosure Statement considered		0
66	10-27-2008 Reference capture on IDS		0
65	10-27-2008 Information Disclosure Statement (IDS) Filed	0	63
64	12-03-2008 Date Forwarded to Examiner		0
63	10-27-2008 Response after Non-Final Action	90	60
62	10-27-2008 Request for Extension of Time - Granted		0
61	10-28-2008 Information Disclosure Statement (IDS) Filed		0
60	04-29-2008 Mail Non-Final Rejection		50
59	04-28-2008 Non-Final Rejection		0
57	02-22-2008 Date Forwarded to Examiner		0
56	02-08-2008 Appeal Brief Filed		0
55	01-22-2008 Notice -- Defective Appeal Brief		0
54	01-16-2008 Appeal Brief Review Complete		0
53	01-16-2008 Date Forwarded to Examiner		0
52.1	12-19-2007 Defective / Incomplete Appeal Brief Filed		0
52	12-19-2007 Appeal Brief Filed		0
51	12-19-2007 Request for Extension of Time - Granted		0
50	06-20-2007 Notice of Appeal Filed	91	43
49	06-20-2007 Request for Extension of Time - Granted		0
48	06-25-2007 Mail Advisory Action (PTOL - 303)		0
47	06-22-2007 Advisory Action (PTOL-303)		0
46	05-30-2007 Date Forwarded to Examiner		0
45	05-21-2007 Amendment after Final Rejection		0
44	05-21-2007 Request for Extension of Time - Granted		0
43	12-21-2006 Mail Final Rejection (PTOL - 326)		0
42	12-18-2006 Final Rejection		0
41	10-10-2006 Date Forwarded to Examiner		0
40	10-02-2006 Response after Non-Final Action	31	38
39	10-02-2006 Request for Extension of Time - Granted		0
38	06-01-2006 Mail Non-Final Rejection		0
37	05-30-2006 Non-Final Rejection		0

36	11-24-2003	Information Disclosure Statement considered		0
35	05-18-2006	Date Forwarded to Examiner		0
34	05-11-2006	Response to Election / Restriction Filed		0
33	04-11-2006	Mail Restriction Requirement	511	0.5
32	04-06-2006	Restriction/Election Requirement		0
31	04-08-2005	Correspondence Address Change		0
30	03-23-2005	Miscellaneous Incoming Letter		0
29	08-12-2004	IFW TSS Processing by Tech Center Complete		0
28	08-12-2004	Case Docketed to Examiner in GAU		0
27	05-03-2004	Preliminary Amendment		0
26	05-19-2004	Reference capture on IDS		0
25.7	11-24-2003	Information Disclosure Statement (IDS) Filed		0
25	11-24-2003	Information Disclosure Statement (IDS) Filed		0
24	05-19-2004	Application Return from OIPE		0
23	05-19-2004	Application Return TO OIPE		0
22	05-19-2004	Application Return from OIPE		0
21	05-20-2004	Application Is Now Complete		0
20	05-19-2004	Application Return TO OIPE		0
19	05-19-2004	Application Return from OIPE		0
18	05-19-2004	Application Is Now Complete		0
17	05-19-2004	Pre-Exam Office Action Withdrawn		0
16	05-19-2004	Application Return TO OIPE		0
15	05-19-2004	Application Dispatched from OIPE		0
14	05-19-2004	Application Is Now Complete		0
13	05-03-2004	Payment of additional filing fee/Preexam	61	5
12	05-03-2004	Applicant has submitted new drawings to correct Corrected Papers problems		0
11	09-16-2003	Claim Preliminary Amendment		0
10	05-03-2004	A set of symbols and procedures, provided to the PTO on a set of computer listings, that describe in		0
9	05-03-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic		0
7	05-03-2004	Applicant has submitted a new specification to correct Corrected Papers problems		0
6	05-13-2004	CRF Is Good Technically / Entered into Database		0
5	12-03-2003	Notice Mailed--Application Incomplete--Filing Date Assigned		0
3	11-13-2003	Cleared by OIPE CSR		0
2	11-11-2003	IFW Scan & PACR Auto Security Review		0
1	09-16-2003	Initial Exam Team nn		0
0.5	09-16-2003	Filing date		0

Close Window

EXHIBIT B

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: **Mail** Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
 or **Fax** (571)-273-2885

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

22852

7590

02/24/2010

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
 LLP
 901 NEW YORK AVENUE, NW
 WASHINGTON, DC 20001-4413

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

Hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/662,808

09/16/2003

Sylvie Roux

03495.0174-02000

2497

TITLE OF INVENTION: IN VIVO MODULATION OF NEURONAL TRANSPORT

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
-------------	--------------	---------------	---------------------	----------------------	------------------	----------

nonprovisional

NO

\$1510

\$300

\$0

\$1810

05/24/2010

EXAMINER	ART UNIT	CLASS-SUBCLASS
----------	----------	----------------

CHEN, SHIN LIN

1632

435-078000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☒ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list

(1) the names of up to 3 registered patent attorneys or agents OR, alternatively,

(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 **Finnegan, Henderson,**2 **Farabow, Garrett & Dunne**3 **LLP**

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Institut Pasteur

Paris, France

Centre Nationale De La Recherche Scientifique

Paris, France

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☒ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

☒ Issue Fee

☒ Publication Fee (No small entity discount permitted)

☐ Advance Order - # of Copies

4b. Payment of Fee(s): (Please first reapply any previously paid issue fee shown above)

☐ A check is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☒ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number **06-0916** (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27.

☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature

Adam Breier

Date

May 12, 2010

Typed or printed name **Adam M. Breier, Ph.D.**

Registration No.

63,718

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Sylvie ROUX et al.)	Group Art Unit: 1632
)	
Application No.: 10/662,808)	Examiner: Shin Lin CHEN
)	
Filed: September 16, 2003)	
)	
For: IN VIVO MODULATION OF)	
NEURONAL TRANSPORT)	Confirmation No.: 2497

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

FEE ADDRESS FOR MAINTENANCE FEE PURPOSES
IN ACCORDANCE WITH 37 C.F.R. 1.363


In accordance with the provisions of 37 C.F.R. 1.363, the fee address set forth below is being supplied for purposes of receiving notices, receipts, and other correspondence relating to the payment of maintenance fees:

ACUMASS	Phone: 33 1727 40000
3, rue Moncey	Fax: 33 1533 28089
75009 Paris	www.acumass.com
FRANCE	Payor Number: 33248

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 12, 2010

By: 
Adam M. Breier, Ph.D.
Reg. No. 63,718
202-408-4000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Sylvie ROUX et al.)	Group Art Unit: 1632
)	
Application No.: 10/662,808)	Examiner: Shin Lin CHEN
)	
Filed: September 16, 2003)	Confirmation No. 2497
)	
For: <i>IN VIVO</i> MODULATION OF)	
NEURONAL TRANSPORT)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**NOTICE OF POSSIBLE PTO ERROR IN THE DETERMINATION OF PATENT TERM
ADJUSTMENT AND REQUEST FOR CLARIFICATION OF CALCULATION**

As required by 65 FED. REG. 56387 (September 18, 2000), Applicant notifies the Patent and Trademark Office (PTO) of a possible error in the patent term adjustment. Applicant confirms receipt of the Notice of Determination of Patent Term Adjustment dated February 24, 2010.

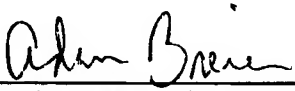
The Notice indicates that the PTO has determined that the patent term adjustment period for this application is 198 days. Applicant respectfully requests that the PTO clarify how it arrived at this adjustment period. Based on Applicant's calculation, at this point in prosecution of this application, the patent term adjustment period should be 188 days.

Please charge any necessary fees required to enter this paper to Deposit
Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 12, 2010

By: 
Adam M. Breier, Ph.D.
Reg. No. 63,718
(202) 408-4000